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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,101	11/03/2000	Francis E. Hayes	CRTEX-001XX	5846
207 7590 11/02/2007 WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP TEN POST OFFICE SQUARE BOSTON, MA 02109			EXAMINER GILLIGAN, CHRISTOPHER L	
			ART UNIT 3626	PAPER NUMBER
			MAIL DATE 11/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/706,101

Applicant(s)

HAYES, FRANCIS E.

Examiner

Luke Gilligan

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, 10 and 15-38 is/are pending in the application.
- 4a) Of the above claim(s) 29-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 10, 15-28, and 33-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/9/07 has been entered.

Response to Amendment

2. In the amendment filed 8/9/07, the following has occurred: claims 1-3, 5-8, 10, 15-16, 19-25, 27-28, and 34-35 have been amended, claims 12-14 have been canceled, and claims 36-38 have been added. Now, claims 1-3, 5-8, 10, and 15-38 are presented for examination with claims 29-32 being withdrawn from consideration.

Claim Objections

3. Claim 36 recites the phrase "a user interface... accessible by a the certificate holder" (emphasis added). Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 recites the limitation "specify insurance coverage information...as restricted in accordance with the restriction criteria entered in the database by the first user..." Although the claim recites "a first user interface under control of a first user to accept...restriction criteria," there is no previous recitation of any type of restricting of insurance coverage information.

There is also no previous recitation of entering the restriction criteria into a database.

Therefore, this limitation lacks proper antecedent basis in the claim. Additionally, there appears to be a missing step or element directed to "restricting."

7. Claim 6 recites similar method limitations to claim 1 and is rejected for the same reasons as given above.

8. Claim 15 contains similar deficiencies to claim 1 and is rejected for the same reasons as given above.

9. Claims 2, 3, 5, 7, 8, 10, 15-28, and 33-35 are rejected for the same reasons as given above through dependency.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 2, 6, 7, 19, 21-23, 33, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheinuk et al., U.S. Patent Application Publication No. 2002/0198745 in view of <http://www.acords.com> (Pages generated through <http://www.archive.org> dated no later than 02/03/1999, pages numbered by Examiner, hereinafter referred to as Choices).

12. As per claim 1, Scheinuk teaches a system for creation of a certificate of insurance and preventing creation of an unauthorized certificate of insurance, relative to an insured party, for a third-party requester, comprising: a database storing insurance coverage information about each of a plurality of insured parties (see paragraph 0009); and a computer system communicably coupled to the database, the computer system including computer program instructions to: a) provide a first user interface under control of a first user to accept, from a first user, an insured name and address and access identification of one of the plurality of insured parties (see paragraph 0044-0045); b) create the certificate of insurance based on specified insurance coverage information (see paragraph 0045).

13. Scheinuk does not explicitly teach inputting restriction criteria. Scheinuk also does not explicitly teach providing a second user interface for a third-party requester to select a specific insured by the access identification and specify insurance coverage information relative to the specific insured to be provided in the certificate of insurance. Choices discloses inputting restriction criteria (see page 2, the Examiner interprets the creation of a certificate using the Certs OnLine to include restriction criteria because it restricts a certificate holder to inputting only a name and address in to a created certificate). Choices further discloses teach providing a second user interface for a third-party requester to select a specific insured by the access identification and specify insurance coverage information relative to the specific insured to be provided in the certificate of insurance (see page 2).

14. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this functionality into the system of Scheinuk. One of ordinary skill in the art would have been motivated to incorporate this functionality for the purpose of further reducing the burden on insurance agency personal by providing immediate web-based access to certificates to certificate holders (see paragraphs 0006-0007 of Scheinuk).

15. As per claim 2, Scheinuk in view of Choices teaches the system of claim 1 as described above. Scheinuk further teaches the database is operable to store information about a plurality of passwords corresponding to at least one of the plurality of insured parties, each of the passwords being associated with a different subset of the insurance coverage information relative to the insured (see paragraph 0049 and Table 2); and the second user interface is operable to accept a password from the second user and to create the certificate of insurance such that the created certificate of insurance contains a subset of the insurance coverage information associated with the entered password (see paragraph 0061). As described above, Scheinuk does not provide the direct access to the third-party requester. However, this functionality is described by Choices as described above. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this functionality into the system of Scheinuk for the reasons given above with respect to claim 1.

16. Claims 6 and 7 recite substantially similar method limitations to those already addressed in system claims 1 and 2 and, as such, are rejected for similar reasons as given above.

17. As per claim 19, Scheinuk in view of Choices teaches the system of claim 1 as described above. Scheinuk further teaches the first user interface is operable to accept an identification of at least one type of insurance carried by the one of the plurality of insured parties and to store the at least one type of insurance in the database in association with the one of the plurality of insured parties (see paragraph 0065); the second user interface is operative to: display the at least one type of insurance corresponding to the one of the plurality of insured parties (see paragraph 0066); allow the second user to select the displayed at least one type of insurance (see paragraph 0066); and the computer system is operative to create the certificate of insurance based on the selected at least one type of insurance (see paragraph 0069). As described above, Scheinuk does not provide the direct access to the third-party

requester. However, this functionality is described by Choices as described above. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this functionality into the system of Scheinuk for the reasons given above with respect to claim 1.

18. As per claim 21, Scheinuk in view of Choices teaches the system of claim 19 as described above. Scheinuk further teaches the first user interfaces is operative to input an indication that the words "Endeavor to" may be omitted from a cancellation clause in a certificate of insurance associated with the one of the plurality of insured parties and to store the indication in the database in association with the one of the plurality of insured parties (see paragraph 0062); and the computer system is operative, responsive to the association of said indication with said insured party, for preventing removal of the words "Endeavor to" in a cancellation clause of the generated certificate of insurance (see paragraph 0062).

19. As per claim 22, Scheinuk in view of Choices the system of claim 19 as described above. Scheinuk further teaches the first user interface is operative to present a list of insurance options that includes those listed and to permit the first user to select at least one of the list of insurance options and the computer system is operative to store the selected at least one insurance option in the database in association with the one of the plurality of insured parties (see paragraph 0071); the second user interface is operative, responsive to the selected at least one insurance option to display only the selected at least on insurance option (see paragraph 0066).

20. As per claim 23, Scheinuk in view of Choices teaches the system of claim 19 as described above. Scheinuk further teaches the first user interface is operative to input revised additional insured wording to be included in the generated certificate of insurance (see paragraph 0071); and the computer system is operative to insert the revised wording into the

generated certificate of insurance in response to an indication of an additional insured option by the second user (see paragraph 0071). As described above, Scheinuk does not provide the direct access to the third-party requester. However, this functionality is described by Choices as described above. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this functionality into the system of Scheinuk for the reasons given above with respect to claim 1.

21. As per claim 33, Scheinuk in view of Choices teaches the system of claim 2 as described above. Scheinuk further teaches providing a third user interface to accept, from a third user, at least one password and an identification of a subset of the insurance coverage information stored in the database and associated with the third user and to associate the at least one password with the identified subset of the insurance coverage information (see paragraph 0049 and Table 2).

22. Claims 35 and 36 recite substantially similar additional limitations to those already addressed in claim 1 and, as such are rejected for similar reasons as given above.

23. Claims 15-18, 37, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheinuk et al., U.S. Patent Application Publication No. 2002/0198745 in view of <http://www.acords.com> (Pages generated through <http://www.archive.org> dated no later than 02/03/1999, pages numbered by Examiner, hereinafter referred to as Choices) and Leming, Chubb lets shippers review, download certificates online (hereinafter Leming, paragraphs numbered by Examiner) and further in view of Grow, U.S. Patent No. 6,694,315.

24. As per claim 15, Scheinuk in view of Choices teaches the method of claim 16 as described above. Scheinuk does not explicitly teach the additional recited steps. Leming teaches an online certificate of insurance system that includes the feature of allowing various

parties to enter free-form text into a certificate of insurance to be generated if access is authorized (see paragraph 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the combined system of Scheinuk and Choices. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of providing the flexibility of adding wording that may be required by relevant parties in certain cases (see paragraph 6).

25. Furthermore, Grow teaches an automated document creation system that includes boxes for entering text to be automatically entered in legal documents (see column 6, lines 23-42). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Scheinuk. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of enhancing the efficiency of the document creation process within Scheinuk and to provide custom tailored application for different entities within the document creation process (see column 2, lines 1-4 of Grow).

26. As per claim 16, Scheinuk in view of Choices, Leming and Grow teach the method of claim 15 as described above. Scheinuk further teaches the second user interface is responsive to whether or not any text was entered (see paragraph 0089).

27. As per claim 17, Scheinuk in view of Choices, Leming, and Grow teach the system of claim 16 as described above. Scheinuk does not explicitly teach forming a complete sentence responsive to a selected one of a plurality of items listed within a pull down menu. Grow teaches forming complete sentences responsive to a selected one of a plurality of items listed within a pull down menu (see column 12, lines 21-33). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Scheinuk for the reasons given above with respect to claim 15.

28. As per claim 18, Scheinuk in view of Choices, Leming, and Grow teach the system of claim 17 as described above. Scheinuk does not explicitly teach said pull down menu is one of a plurality of pull down menus, wherein each pull down menu is associated with an insurance type. Grow teaches said pull down menu is one of a plurality of pull down menus, wherein each pull down menu is associated with a predetermined event (see column 12, lines 21-33). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Scheinuk for the reasons given above with respect to claim 15.

29. Claims 37-38 recite substantially similar additional limitations to those already addressed in claims 15-18 and, as such are rejected for similar reasons as given above.

30. Claims 3, 5, 8, 10, 24-26, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheinuk et al., U.S. Patent Application Publication No. 2002/0198745 in view of <http://www.acords.com> (details as described above) and further in view of Luchs et al., U.S. Patent No. 4,831,526.

31. As per claim 3, Scheinuk in view of Choices teaches the system of claim 1 as described above. Scheinuk further teaches the database is operable to store information about an approving party corresponding to at least a subset of the insurance coverage information corresponding to at least one of the plurality of insured parties (see paragraph 0049); and the computer system is operative to send an electronic message prior to generating the certificate of insurance, the electronic message including at least a portion of a proposed certificate of insurance and to generate a certificate of insurance (see paragraph 0094-96). Scheinuk does not explicitly teach only generating a certificate of insurance if an approval response is received from the approving party. Luchs teaches only generating an insurance document if an approval

response is received from an approving party (see column 6, lines 13-24). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Scheinuk. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of reducing errors in the generation of certificates of insurance by first checking with an approving party (See paragraph 0006 of Scheinuk).

32. As per claim 5, Scheinuk in view of Choices and Luchs teaches the system of claim 3 as described above. Scheinuk further teaches the at least a portion of the proposed certificate of insurance included in the electronic message is modifiable by the approving party and the generated certificate of insurance is generated according to modifications made by the approving party (see paragraphs 0089-0090).

33. Claims 8 and 10 recite substantially similar method limitations to those already addressed in system claims 3 and 5 and, as such, are rejected for similar reasons as given above.

34. Claims 24-26 contain substantially similar additional limitations to those already addressed in claims 3 and 5 and, as such, are rejected for similar reasons as given above.

35. Claim 34 recites substantially similar additional limitations to those already addressed in claim 3 and, as such is rejected for similar reasons as given above.

36. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scheinuk et al., U.S. Patent Application Publication No. 2002/0198745 in view of <http://www.acords.com> (details as described above) and further in view of McKee et al., U.S. Patent No. 6,272,482.

37. As per claim 20, Scheinuk in view of Choices teaches the system of claim 19 as described above. Scheinuk further teaches the second user interface is operable to a input a requested number of cancellation days (see paragraph 0067). Scheinuk does not explicitly

teach inputting a maximum and minimum number of cancellation days for comparison to a requested number of cancellation days and comparing this data to produce the error messages. McKee teaches the use of business rules to establish a maximum and minimum number of cancellation days (see column 4, lines 38-51). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these rules into the system of Scheinuk. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of complying with state laws regarding cancellation (see column 4, lines 61-66 of McKee).

Response to Arguments

38. In the remarks filed 8/9/07, Applicants argue in substance that (1) Choices does not allow a third party to make changes related to the insurance coverage provided by the certificate of insurance; (2) none of the prior art teaches restricting input into the certificate of insurance based on restriction criteria; (3) there is no motivation to combine the prior art references; (4) Scheinuk does not teach sending an electronic message to an approving party; (5) McKee teaches adjustment of a notification period not a cancellation period.

39. In response to Applicant's argument (1), as noted in the above rejection, the Examiner has broadly interpreted the inputting of name and address to be a form of inputting "insurance coverage information" as recited in the claim. It should be noted that the claims do not actually recite adjusting the insurance coverage provided by the certificate of insurance. They merely recite steps and functions directed to editing the data to be included in a certificate of insurance. Therefore, at most, the claims merely label the data differently from that of the prior art. However, such labeling does not distinguish the claims from the prior art.

40. In response to Applicant's argument (2), as noted in the above rejections under 35 U.S.C. 112, it is unclear how the phrase "as restricted by" limits the scope of the claims in light of the fact that there is no recited step of "restricting." Therefore, this argument is not found to be persuasive in view of the claims as currently recited.

41. In response to Applicant's argument (3), It is respectfully submitted that the Examiner has provided a clear motivation for combining each of the applied prior art references. In addition, the applied rejections do not change the intended function of the prior art references and the combination of teachings yields predictable results. Therefore, it is respectfully maintained that there is sufficient rationale to combine the teachings of the prior art as applied above.

42. In response to Applicant's argument (4), the Examiner is interpreting the "user" of Scheinuk to be the recited "approving party." At paragraph 0094-0096, the user must be sent an electronic message (i.e. a message displayed on a screen) prior to creating and sending the certificate of insurance because the user at least selects the mode of communication of the certificate.

43. In response to Applicant's argument (5), the Examiner is interpreting the number of days for notification of cancellation to be a form of cancellation days as recited in the claim. The claims do not specify adjusting a date of cancellation, which is what Applicant's appear to be arguing.


Conclusion

44. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

45. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

46. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

10/29/07


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